

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHINORI SANO

Appeal 2006-3011
Application 10/123,110
Technology Center 1700

Decided: November 20, 2006

Before KIMLIN, KRATZ, and TIMM, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-13. Claim 1 is illustrative:

1. A golf club head which comprises a metallic basal body and a multilayer coating thereon, said multilayer coating comprising:
 - a foundation coat of a priming paint;
 - a color coat of a coloring paint;

an iridescent coat of an iridescent paint; and

a clear coat of a transparent and colorless paint,

which coats are arranged in this order from the inside to the outside, wherein the coloring paint comprises a resin and a pigment;

the iridescent paint comprises a resin, a colorant and an iridescent material;

said iridescent material is at least one kind of flakes selected from the group consisting of colored aluminum flakes, metal flakes with a resin-treated surface, mica flakes coated with a titanium oxide, and uncoated flakes of mica;

the iridescent coat has a thickness of from 10 to 40 microns;

the pigment of the coloring paint is a color different from that of the colorant of the iridescent paint;

the resin of the iridescent paint is a transparent resin through which the color of the pigment is recognizable; and

the overall thickness of the multilayer coating is not more than 100 microns.

In addition to the prior art acknowledged in Appellant's Specification, the Examiner relies upon the following references as evidence of obviousness:

Bradstreet	US 2,908,502	Oct. 13, 1959
Molitor	US 4,204,684	May 27, 1980

Appellant's claimed invention is directed to a golf club head comprising a metallic base and subsequently applied coats of a primary

paint, a coloring paint, an iridescent paint and a transparent colorless paint. The iridescent paint comprises a resin, a colorant and an iridescent material, such as flakes of aluminum, mica, and mica flakes coated with a titanium oxide. According to Appellant's Specification, "[a]n object of the present invention is therefore to provide a golf club head which is iridescent and will be appreciated by many golfers as being more beautiful and high-quality than those of the pearl paint coating or metallic pigmented paint coating" (page 1 of Specification, penultimate paragraph).

Appealed claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in view of Bradstreet and Molitor.

In view of the arguments set forth at pages 9-10 of Appellant's principal Brief, the following groups of claims stand or fall together:

- (a) claims 1 and 9;
- (b) claims 2, 10 and 11;
- (c) claims 3-5 and 12;
- (d) claims 6 and 13;
- (e) claims 7 and 8.

We have thoroughly reviewed each of Appellant's arguments for patentability. However, we concur with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's rejection.

The admitted prior art depicted in Figure 3 of Appellant's Specification is a golf club head comprising a metal base and the presently claimed coat of a priming paint, a metallic paint and a clear coat of a

transparent and colorless paint. The golf club head of the admitted prior art does not include the claimed iridescent coat of an iridescent paint. However, we agree with the Examiner that Bradstreet and Molitor evidence the obviousness of adding a coating of iridescent paint to the golf club head of the admitted prior art for the known benefit of enhancing the aesthetic appearance of the club head (see Molitor at col. 5, ll. 33-35). It was certainly well known in the art to use coatings of iridescent material on a large variety of articles for aesthetic purposes, and Bradstreet and Molitor provide evidence that one such known article was a golf club head.

We do not understand Appellant's argument that "[a]s acknowledged by the Examiner, the described Conventional Art does not include ... (1) a color coat of a coloring paint which includes a pigment" (page 6 of principal Br., penultimate paragraph). The Examiner acknowledges no such thing but, rather, submits that the admitted prior art "discloses a conventional pearl painting for a golf club with a triple-layer coating comprising: a colorless priming paint (b); colorant paint coating (c); and a clear coat (d)" (page 3 of Answer, last paragraph). Manifestly, in the Conventional Art of Appellant's Figure 3, layer (c) is a color coat of a coloring paint including a pigment.

Appellant also contends that there is no basis in fact for the Examiner's finding that a coating of Bradstreet has properties of iridescent material. However, the factual basis resides in Bradstreet's disclosure of a coating containing crypto crystalline titanium oxide (col. 2, ll. 9 et seq.), which corresponds to the titanium oxide-coated mica flakes of the claimed invention. Appellant maintains that the crypto crystalline titanium oxide coating of Bradstreet produces a dark coating that is applied by flame-spray. However, flame-spraying that produces a black coating is only one method

of applying the titanium oxide taught by Bradstreet. The reference also teaches that the "coatings may be applied to golf clubs by any known means as, for example, by spraying, painting or dipping" (col. 1, ll. 58-60). It is reasonable to conclude that titanium oxide applied by painting or dipping would be iridescent and not almost black, at least to the same degree as Appellant's titanium oxide. As for the claimed iridescent paint having a colorant and an iridescent material, the recited colorant and iridescent material may be one and the same material. Moreover, we agree with the Examiner that Bradstreet suggests that the coating comprising an iridescent material may also contain a colorant (col. 3, ll. 10-12).

Appellant also maintains that Molitor makes it clear that "the disclosed golf club does not include any substantial metallic basil body, as employed in the conventional design of Figure 3," and that the entire golf club head of Molitor is made from plastic layers (page 8 of principal Br., penultimate paragraph). However, Molitor is cited as evidence for the obviousness of using an iridescent coat comprising an iridescent material on a golf club head to enhance its aesthetic appearance. We find that one of ordinary skill in the art would have found it equally obvious to enhance the aesthetic appearance of golf club heads comprising both a metallic base and a wood base.

Concerning the flakes of the iridescent material being generally oriented in a certain direction with respect to the surface of the head (claim 3), or generally oriented in a direction parallel to the surface of the head (claim 4), or generally oriented in a direction normal to the surface of the head (claim 5), Molitor teaches that "the flake pigments become generally oriented parallel to the surface" (col. 6, ll. 1-2), and Appellant's Specification

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attaches no criticality to the general orientation of the flakes of iridescent material. Hence, we find that it would have been an obvious matter of design choice to orient the flakes in accordance with the desired appearance.

As a final point, we note that Appellant bases no argument upon objective evidence of nonobviousness, such as unexpected results, which would serve to rebut the *prima facie* case of obviousness established by the Examiner.

In conclusion, based on the foregoing, the Examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv)(effective Sept. 13, 2004).

AFFIRMED

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BIRCH, STEWART, KOLASCJ & BIRCH
P. O. Box 747
Falls Church, VA 22040-0747